UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,290	05/19/2000	Naozumi Takenaka	13700	1281

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EXAMINER
TODD, GREGORY G

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/575,290	TAKENAKA ET AL.
	Examiner	Art Unit
	Gregory G. Todd	2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 January 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>9-12</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>9-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This is a fifth office action in response to applicant's amendment filed, 26 January

2006, of application filed, with the above serial number, on 19 May 2000 in which no

claims have been amended. Claims 9-12 are therefore pending in the application.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Geiger et al (hereinafter "Geiger", 6,463,534) in view of Arent (hereinafter "Arent",

6,018,724).

As per Claim 9, Geiger teaches a service providing system comprising:

a network having

an information providing server which provides information (at least col. 10, lines

55-64; col. 13, lines 13-42; eg. third party or merchant server), and

an authentication server capable of sending and receiving information to and

from the information providing server (at least col. 10, lines 38-64; col. 12, lines 19-31;

validation server for server authentication); and

a portable terminal capable of sending and receiving information to and from the

network (at least col. 8, lines 28-45; wireless client device connecting to network);

wherein the information providing server is configured to send to the

authentication server information requested by the portable terminal, address

information associated with the information providing server, and tag information

associated with the information providing server (at least col. 10, lines 38-64; col. 12,

lines 19-31; cross certificates for server authentication, in addition to keys);

wherein the authentication server has an authentication information database

which stores authentication information to determine whether or not the information

providing server is an authorized server, the authentication information being

displayable on the portable terminal (at least col. 13, lines 10-23; validation server);

wherein the authentication server has a detector which detects whether or not

the address information and the tag information sent by the information providing server

match the authentication information stored in the authentication information database

(at least col. 10, lines 38-54; cross certificates for server authentication, in addition to

keys);

wherein the authentication server has a transmitter which sends to the portable

terminal the requested information sent by the information providing server and the

authentication information retrieved from the authentication database when the address

information and the tag information match the stored authentication information (at least

col. 13, lines 13-67; delivering content to client); and

wherein the portable terminal has a first display area which displays the

requested information sent by the information providing server (at least col. 13 line 66 -

col. 14 line 8).

Geiger fails to explicitly teach a second display area which displays the

authentication information. However, the use and advantages for displaying such

information is well known to one skilled in the art at the time the invention was made as

evidenced by the teachings of Arent. Arent teaches displaying authentication and

certificate information (at least Fig. 3-6; col. 3, line 15 - col. 4 line 64) containing, as is

well known in the art, status information of the authenticity of the other party in

communication. Therefore, it would have been obvious to one of ordinary skill in the art

at the time the invention was made to incorporate the use of Arent's displaying

authentication information into Geiger's system as this would enhance Geiger's display

to allow the user to constantly know the status of their connection with the server and

know the status of the trust with the website the user is in communication with, as Arent

teaches this would alleviate concerns for a user accessing an online merchant and

making purchases (at least col. 3, lines 1-14).

As per Claim 10. The service providing system of Claim 9, wherein the portable terminal

further includes a radio transmitter to access the network via wireless communication

(at least col. 8, lines 28-45).

As per Claim 11, Geiger teaches a service providing method using a portable terminal

which can be connected to a network having an information providing server and an

authentication server connected to the information providing server, the method

comprising:

the portable terminal accessing the network to request information (at least col.

8, lines 28-45; wireless client device connecting to network);

the information providing server transmitting to the authentication server the

information requested by the portable terminal, address information for the information

providing server, and tag information (at least col. 10, lines 38-64; col. 12, lines 19-31;

cross certificates for server authentication, in addition to keys);

the authentication server determining whether the received address information

and tag information match address information and tag information stored in the

authentication server (at least col. 10, lines 38-54; cross certificates for server

authentication, in addition to keys);

the authentication server converting the received tag information to

authentication information displayable on the portable terminal when the received

address information and tag information match the stored address information and

stored tag information, and sending the requested information sent by the information

providing server and the authentication information to the portable terminal (at least col.

13, lines 13-67; delivering content to client and viewing of the certificate by the user);

and

the portable terminal displaying the requested information on a first display area

(at least col. 13 line 66 - col. 14 line 8)

Geiger fails to explicitly teach a second display area which displays the authentication information. However, the use and advantages for displaying such information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Arent. Arent teaches displaying authentication and certificate information (at least Fig. 3-6; col. 3, line 15 - col. 4 line 64) containing, as is well known in the art, status information of the authenticity of the other party in communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Arent's displaying authentication information into Geiger's system as this would enhance Geiger's display to allow the user to constantly know the status of their connection with the server and know the status of the trust with the website the user is in communication with, as Arent teaches this would alleviate concerns for a user accessing an online merchant and making purchases (at least col. 3, lines 1-14).

As per Claim 12. The service providing method of Claim 11, wherein the portable terminal accesses the network via wireless communication (at least col. 8, lines 28-45).

4.   Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger et al (hereinafter "Geiger", 6,463,534) in view of Kolev et al (hereinafter "Kolev", 6,356,753).

As per Claim 9, Geiger teaches a service providing system comprising:

a network having

an information providing server which provides information (at least col. 10, lines

55-64; col. 13, lines 13-42; eg. third party or merchant server), and

an authentication server capable of sending and receiving information to and

from the information providing server (at least col. 10, lines 38-64; col. 12, lines 19-31;

validation server for server authentication); and

a portable terminal capable of sending and receiving information to and from the

network (at least col. 8, lines 28-45; wireless client device connecting to network);

wherein the information providing server is configured to send to the

authentication server information requested by the portable terminal, address

information associated with the information providing server, and tag information

associated with the information providing server (at least col. 10, lines 38-64; col. 12,

lines 19-31; cross certificates for server authentication, in addition to keys);

wherein the authentication server has an authentication information database

which stores authentication information to determine whether or not the information

providing server is an authorized server, the authentication information being

displayable on the portable terminal (at least col. 13, lines 10-23; validation server);

wherein the authentication server has a detector which detects whether or not

the address information and the tag information sent by the information providing server

match the authentication information stored in the authentication information database

(at least col. 10, lines 38-54; cross certificates for server authentication, in addition to

keys);

wherein the authentication server has a transmitter which sends to the portable

terminal the requested information sent by the information providing server and the

authentication information retrieved from the authentication database when the address

information and the tag information match the stored authentication information (at least

col. 13, lines 13-67; delivering content to client); and

wherein the portable terminal has a first display area which displays the

requested information sent by the information providing server (at least col. 13 line 66 -

col. 14 line 8).

Geiger fails to explicitly teach a second display area which displays the

authentication information. However, the use and advantages for displaying such

information is well known to one skilled in the art at the time the invention was made as

evidenced by the teachings of Kolev. Kolev teaches displaying an authentication

indicator (at least Fig. 1; col. 5, lines 17-50) to a user on a display to verify

authentication flag information. Therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to incorporate the use of Kolev's

displaying an authentication indicator into Geiger's system as this would enhance

Geiger's display to allow the user to constantly know the status of their connection with

the server and know the status of the trust with the website the user is in communication

with, as is desirable, as Kolev teaches this would increase confidence in the security

and confidentiality capabilities of a wireless network (at least col. 1, lines 43-57).

As per Claim 10. The service providing system of Claim 9, wherein the portable terminal

further includes a radio transmitter to access the network via wireless communication

(at least col. 8, lines 28-45).

As per Claim 11, Geiger teaches a service providing method using a portable terminal

which can be connected to a network having an information providing server and an

authentication server connected to the information providing server, the method

comprising:

the portable terminal accessing the network to request information (at least col.

8, lines 28-45; wireless client device connecting to network);

the information providing server transmitting to the authentication server the

information requested by the portable terminal, address information for the information

providing server, and tag information (at least col. 10, lines 38-64; col. 12, lines 19-31;

cross certificates for server authentication, in addition to keys);

the authentication server determining whether the received address information

and tag information match address information and tag information stored in the

authentication server (at least col. 10, lines 38-54; cross certificates for server

authentication, in addition to keys);

the authentication server converting the received tag information to

authentication information displayable on the portable terminal when the received

address information and tag information match the stored address information and

stored tag information, and sending the requested information sent by the information

providing server and the authentication information to the portable terminal (at least col.

13, lines 13-67; delivering content to client and viewing of the certificate by the user);

and

the portable terminal displaying the requested information on a first display area

(at least col. 13 line 66 - col. 14 line 8)

Geiger fails to explicitly teach a second display area which displays the

authentication information. However, the use and advantages for displaying such

information is well known to one skilled in the art at the time the invention was made as

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skill in the art at the time the invention was made to incorporate the use of Kolev's

displaying an authentication indicator into Geiger's system as this would enhance

Geiger's display to allow the user to constantly know the status of their connection with

the server and know the status of the trust with the website the user is in communication

with, as is desirable, as Kolev teaches this would increase confidence in the security

and confidentiality capabilities of a wireless network (at least col. 1, lines 43-57).

As per Claim 12. The service providing method of Claim 11, wherein the portable

terminal accesses the network via wireless communication (at least col. 8, lines 28-45).

Response to Arguments

5.   Applicant's arguments filed 26 January 2006 have been fully considered but they

are not persuasive.

Applicants argue, in substance, that Geiger fails to teach the information providing server sending to the authentication server the associated required information, as well as an authentication server detector.

In response, Geiger clearly teaches these features as Geiger teaches a CA (authentication) server (col. 3, lines 10-13) in communication with at least one server (eg. third party, merchant, etc) in communication with a client device (col. 8, lines 28-62) where the server delivers the content to the device / user and the CA server maintains licenses and certificates databases, wherein if a user requests a document with license, for example, the request would go to the server and then license information would be sent to the CA server, a license would go to the server which would then transit the document with license to the user/ device, thus transmitting said information to the authentication server. Geiger further teaches cross-certificates between servers (col. 10, lines 38-64) wherein the servers are verified, validated, authenticated accordingly so as the whole process to be secure.

Applicants further argue that Arent fails to teach the authentication information displayed on the portable terminal being retrieved from the authentication database, and instead teaches it being selected by the user. In response, what Applicant suggests is clearly not what Arent is teaching. Arent teaches the certification indicator (500) (col. 4, lines 51-64) being supplied by the supplier of the user's merchant authentication code and being retrieved and combined after a merchant or third party is authenticated (col. 5, lines 1-11). While the indicator (500) would consist of a user defined component (520), this is only to further enhance security and is not, as Applicant suggests,

authentication information selected by the user. Rather, the user does initially supply the

component so as a future communication can be verified by the user as truly being

authentic via 520 while any other entity would know the data to be authentic from 510,

the combination of 510 and 520 being 500.

Applicants further argue Kolev does not teach the information displayed in the

display is retrieved from an authentication database when the address information and

the tag information sent from the information providing server match the stored

authentication information.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). In this case, Kolev is only relied on to demonstrate a second display area which

displays the authentication information. Geiger, on the other hand, is relied on for

teaching a first display area along with the authentication procedures.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Newly cited Joyce et al (mobile voucher system with later filing date), in addition to previously cited Kiessling et al, Hamalainen et al, Kay, Katz et al, Talati et al, Hiroya et al, Ramasubramani et al, Hultgren and Valtanen are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G. Todd whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
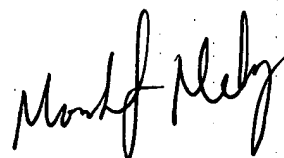
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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Gregory Todd

Patent Examiner

Technology Center 2100

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